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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,481	07/01/2003	Jimmy Lee Long	ITW-14146	3481
44702	7590	07/03/2006	EXAMINER	
OSTRAGER CHONG FLAHERTY & BROITMAN PC 250 PARK AVENUE, SUITE 825 NEW YORK, NY 10177				HARMON, CHRISTOPHER R
ART UNIT		PAPER NUMBER		
		3721		

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/612,481	LONG, JIMMY LEE	
	Examiner	Art Unit	
	Christopher R. Harmon	3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 April 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-11 and 13-21 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-11 and 13-20 is/are rejected.
- 7) Claim(s) 21 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Objections

1. Claim 21 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 12 has been cancelled (claim 21 is dependent thereon).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1-2 and 5-6 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by van Overbruggen et al. (US 4,334,640).

Van Overbruggen et al. disclose a circular cylindrical tube 14 made of resilient material forming an airtight outer boundary of a chamber; first 11 and second 15 end cap assemblies supporting the tube at opposite ends; fixed structure 20 supporting first and second rotatable end cap assemblies which comprises a passageway in fluid communication with the chamber; see figure 2.

Regarding claim 11, hard roller on crimping device 6 forms a nip with the assembly described supra, see figure 1.

Art Unit: 3721

4. Claims 1-2, 5-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Kluge et al. (US 3,808,350).

Kluge et al. disclose a circular cylindrical tube 3 made of resilient material forming an airtight outer boundary of a chamber; first 5 and second 15 end cap assemblies supporting the tube at opposite ends; fixed structure 12 supporting first and second rotatable end cap assemblies which comprises a passageway in fluid communication with the chamber; see figure 1. The chamber 10 defined by sleeve 12 is in communication with inlets/outlets 7-9 and 16; see figures 1-2. Transverse cuts 16 are disposed within the tube from an inner surface of the tube at spaced intervals and constant depth; see figure 2.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer (US 3,983,310).

Fischer discloses an improvement upon the invention to Kluge et al. '350 comprising the invention as described supra and end cap 5 with a fitted bearing 11, see figure 1. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the bearing structure on the opposite end cap for eliminating damage to the tube caused by twisting. Regarding claims 4 and 10, note that it has

been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

In re Leshin, 125 USPQ 416. Therefore, it would have been obvious to one of ordinary skill in the art to make the respective end caps of hard molded rubber and the bearings ultra-high molecular weight plastic material.

6. Claims 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kane (US 6,212,984) in view of Satoh et al (#6,382,100).

Kane discloses a nip roller/tube 58 made of resilient material 60 forming a pneumatic chamber extending the length of the tube connected to radial ports 62 throughout the circumferential surface mounted on a fixed structure 52; see figures 2-4. The tube 58 forms a nip with hard roller 56.

The specific design of the nip roller/resilient tube of Kane is not detailed, however Satoh et al. shows an assembly comprising a tube with a chamber (at least a portion forming an airtight outer peripheral boundary ie. between ducts) with first and second end caps 46 that are secured to fixed structure 50. Satoh et al show an air passageway 52 that extends through shaft 5, pneumatic roller 3 that is rotatably mounted on shaft means and shows shaft 5 being nonrotatable (col 7 lines 7+). Satoh et al disclose a pair of bearing means 6 (one shown). Satoh et al show transverse cut means as claimed as shown in figure 2 as well as the cuts being axially spaced.

It would have been obvious to one of ordinary skill in the art to look to the teachings of Satoh et al. for construction of the rotating pneumatic roller/tube made of a

resilient material of Kane for communicating a fluid between a known source and the tube.

Regarding the slider assembly product as claimed, the examiner notes that expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. See *ex parte Thibault*, 164 USPQ 666, 667 (Bd App. 1969). Furthermore, inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims. *In re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)).

Regarding specific materials being claimed, such as, the material for the bearing, soft-cell rubber, hard rubber, etc. the examiner notes that mere selection of known materials for their intended use are entirely obvious. See *In re Leshin*, supra.

Response to Arguments

7. Applicant's arguments filed 4/7/06 have been fully considered but they are not persuasive. Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.

Claim 13 merely requires at least a portion of the tube to form an airtight boundary. During patent examination, the claims are given the broadest reasonable interpretation consistent with the specification. See *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997). See MPEP § 904.1. Therefore the limitation is taught by Satoh '100 and/or Kane. The modification of Kane by the structure of the roller of Satoh yields all claim limitations. In response to applicant's argument that there is no

suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, each Kane and Satoh employ rollers in communication with a pneumatic system. Because Kane does not clearly discuss the details of tube 58 the reference to Satoh would have been readily available to one of ordinary skill in the art.

Regarding claim 18, transverse cuts do not reach “an outer peripheral surface” of the tube of Kane defined by cutting edge 61.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

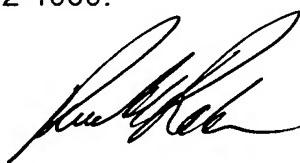
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Harmon whose telephone number is (571) 272-4461. The examiner can normally be reached on Monday-Friday from 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ch



Rinaldi I. Rada
Supervisory Patent Examiner
Group 3700